

**REMARKS**

**I. STATUS OF CLAIMS AND FORMAL MATTERS**

Claims 9 and 12-25 are pending in this application. Claims 1-8 are cancelled. No new matter is added.

It is submitted that the claims are patentably distinct over the prior art and that these claim are and were in full compliance with the requirements of 35 U.S.C. § 112. The amendments of the claims are not made for the purpose of patentability within the meaning of 35 U.S.C. §§ 101, 102, 103 or 112; but simply for clarification and to round out the scope of protection to which Applicants are entitled. Furthermore, it is explicitly stated that these amendments should not give rise to any estoppel, as they are not narrowing amendments.

**II. THE RESTRICTION REQUIREMENT SHOULD BE REDRAWN**

The Examiner is thanked for reconsidering her original restriction requirement and examining claims to ORFs 4 and 13 in view U.S. Patent No. 6,943,152 (“the ‘152 patent”). Applicants again ask for reconsideration regarding the restriction of claims reciting additional pig pathogens. There are several bases supporting the argument that claims 13-16, 20 and 21 are not a separate invention.

The first reason for not restricting out claims directed to an additional pig pathogen is based upon the Examiner’s own logic. The Examiner agreed to consider ORFs 4 and 13 “in order to maintain consistency” with the ‘152 patent. The Examiner’s attention is directed to dependent claims 8 and 30 of the ‘152 patent, which recite “an immunogen from a porcine pathogenic agent other than PCV-2.” In the interest of maintaining consistency, claims 13-16, 20 and 21 should be examined in this application.

More importantly, claims 13-16, 20 and 21 cannot be a separate invention from the claims from which they depend. Claims 9 and 12 recite compositions comprising a carrier and an active agent. The use of the open transition “comprising” means that the composition can contain additional components. Dependent claims 13-16, 20 and 21 simply narrow down the universe of what those additional components can be. Even if Applicants had never submitted claim 13, for example, claims 9 and 12 would still inherently encompass a method for reducing viral load of PCV-2 by administering a composition containing the carrier, recited vector and an additional pathogen because of the use of the term “comprising.”

The MPEP lists two criteria for a proper restriction requirement. First, the inventions must be independent or distinct. (MPEP § 803) Second, searching the additional inventions must constitute an undue burden on the Examiner if restriction is not required. *Id.* Dependent claims reciting additional components of composition that is already described using “comprising” language cannot fit into either of these categories. The Examiner has not shown how these could be independent and distinct, other than to say that they are. Moreover, there is no way that a proper search and examination of claims that recite a composition comprising certain components could not include compositions having components in addition to those recited. The Examiner’s assertion that “[s]earching the claimed composition and additionally, another pathogen, would be serious burden of search” (Office Action, page 4) calls into question the adequacy of the search performed for claims 9 and 12. Restriction of claims 13-16, 20 and 21 has not been shown to be proper and those claims should be examined in the present application.

### **III. THE REJECTION UNDER 35 U.S.C. § 112, 2<sup>ND</sup> PARAGRAPH IS OVERCOME**

Claims 9, 12, 17-19 and 22-23 were rejected under the second paragraph of Section 112 as allegedly being indefinite. The rejection is traversed. The Examiner expresses uncertainty about the identity of the claimed PCV-2 ORFs. The differences in ORF numbering between the present application and that used in the ‘152 patent are simply a reflection of different researchers initially using different nomenclature. ORF 4 and ORF 13 in the present application refer to the same ORFs as ORF 1 and ORF 2 in the ‘152 patent. Since the nomenclature is not consistent within the art, there is no requirement to conform to a different standard of nomenclature than that which the Applicants have used. The ORF sequences and numbering are clearly defined in the respective documents and the skilled artisan in the field understands the differences in nomenclature. For the Examiner’s convenience, a table of the ORF usages is provided below. In addition to the listed documents, journal references are also available using all three systems of ORF nomenclature. (See also Appendix A of submission filed on September 6, 2006 in U.S.S.N. 10/653,849.)

Usage	6,943,152	10/334,245 10/653,849 11/107,219 11/217,562	6,368,601 6,391,314 6,660,272 6,217,883 6,953,581 6,517,843 6,497,883
	1	1	4
	2	6	13
	3	2	7
	4	3	10
	5	4	5
	6	5	3
	7		1
	8		2
	9		6
	10		8
	11		9
	12		11
	13		12

Reconsideration and withdrawal of the indefiniteness rejection are requested.

#### **IV. THE DOUBLE PATENTING REJECTIONS ARE OVERCOME**

Claims 9, 12, 17-19 and 22-24 were rejected as allegedly being unpatentable over claims 20-22 of U.S. Patent No. 6,497,883 ("the '883 patent) and over claims 22; 46 and 47 of U.S. Patent No. 6,943,152. In order to expedite allowance of this application, a terminal disclaimer to the '883 and the '152 patents is enclosed. This action should not be construed as agreement with the Examiner's position.

Reconsideration and withdrawal of the double patenting rejections are requested.

**CONCLUSION**

This application is in condition for allowance. Favorable reconsideration and a Notice of Allowance are requested.

Respectfully submitted,

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